

No. 6,626,678, which is the parent of and is commonly owned with the present application.

Applicant submits herewith a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c), and requests withdrawal of the present double patenting rejection.

2. Rejection under 35 U.S.C. §103(a) over Foresman in view of BrightSteps.

Claims 21–24, 26 and 33–37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Foresman (U.S. Patent No. 5,865,627) in view of BrightSteps by Infantino. This rejection is respectfully traversed.

It is well established that a *prima facie* case of obviousness requires that all three of the criteria set forth in MPEP §2143 be met. A *prima facie* case of obviousness cannot be sustained in the present situation, for failure to satisfy at least two of the three criteria, as more fully described below.

No suggestion or motivation to combine reference teachings.

It is asserted in the Office Action: “Although Foresman defines the use of foam and not a surface layer formed of a soft fabric, it would have been obvious to one of ordinary skill in the art, in view of ... BrightSteps ..., that educational objects could comprise an outer surface layer formed of a variety of soft fabrics ...”.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” MPEP §2143.01, citing *In re Kotzab*.

The problem to be solved in the present invention is related to improving quality of life for sufferers from dementia (Specification, page 1, lines 18–19) and the present claims specify “an adult subject having a medically diagnosed dementia”. By contrast, Foresman’s device is a teaching aid specifically designed to teach mathematics “to elementary school children, in particular” (Foresman, column 1, lines 6–7), and the BrightSteps toy is addressed to “babies” of age “nine months plus” (see upper right corner of BrightSteps product insert). One of ordinary

skill at the time of the present invention, seeking a solution to the problem of “entertaining and providing an activity focus to dementia patients” (Specification, page 1, lines 28–29), and reading the disclosure of Foresman relating to teaching mathematics to elementary schoolchildren, would not have been motivated to combine Foresman’s teaching, such as it is, with a reference to a toy directed at even younger subjects, namely babies of 9–12 months. Indeed, by their focus on such young subjects, Foresman and BrightSteps each teach away from the present invention, which is directed at adult subjects having a medically diagnosed dementia.

Thus no suggestion or motivation can be found to combine the reference teachings.

All claim limitations not taught or suggested.

Claim 21 defines not only a kit to be used according to the therapeutic method of that claim, but further specifies that the method comprises “causing an adult subject having a medically diagnosed dementia to use as a cognitive activity aid” such a kit. Furthermore, Claim 21 recites that said use provides a therapeutically beneficial cognitive challenge appropriate to the mental acuity of such a subject, *i.e.*, an adult subject having a medically diagnosed dementia. All other pending claims depend from Claim 21, thus embody all limitations of Claim 21.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP §2143.03, citing *In re Wilson*. It is respectfully pointed out that the Examiner has focused on the kit itself and ignored the method of use of the kit, which a reading of Claim 21 as a whole will show is the subject matter for which patent is presently sought.

The combination of Foresman and BrightSteps, even if such combination were proper (which is not admitted herein), contains no teaching or suggestion of use of their subject articles as a cognitive activity aid for adult subjects having a medically diagnosed dementia, as presented in Claim 21.

Thus the reference teachings, even if motivation could be found to combine them, would not lead one of ordinary skill in the art to the present invention, as not all claim limitations are taught or suggested by a combination of the references.

For at least the reasons set forth above, Applicant respectfully submits that a *prima facie* case of obviousness has not been made, and requests withdrawal of the present rejection under 35 U.S.C. §103(a).

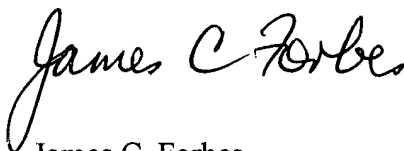
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Response to Office Action dated June 24, 2004

3. Allowable subject matter.

It is noted that Claims 25, 31 and 32 have been found allowable, subject to their rewriting in independent form including all of the limitations of the base claim and any intervening claims.

Applicant elects to defer amendment of these claims for allowance, pending reconsideration by the Examiner of the rejected base and intervening claims, in light of Applicant's submission herein. Applicant believes the present application is in condition for allowance of all pending claims.

Respectfully submitted,

A handwritten signature in black ink that reads "James C. Forbes". The signature is written in a cursive, flowing style.

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Attachment:

Terminal Disclaimer